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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,711	08/01/2003	Dennis A. Carson	023070-124010US	2786
20350 7590 01/14/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER KWON, BRIAN YONG S	
			ART UNIT 1614	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,711

Applicant(s)

CARSON ET AL.

Examiner

Brian S. Kwon

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,31-41,51-58 and 63 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☐ Claim(s) is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☒ Claim(s) 1-26,31-41,51-58 and 63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date .
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date .
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: .

DETAILED ACTION

1. Acknowledgement is made of applicants' filing of the instant application as a Request for Continued Examination (RCE) under 37 CFR 1.1114.
2. Acknowledgement is made of applicant's filing of an amendment on 09/25/2007. By the amendment, claims 27-30, 42-50 and 58-62 have been amended and claim 63 has been newly added.

Newly submitted claim 63 is directed to an invention which is identical to the subject matter of Group III invention that was restricted out (see Restriction Requirement issued on 08/24/05). Although it is proper to group claim 63 with the Group III invention, upon further consideration, the examiner withdraws the restriction requirement between Group I and Group III because of the search of subject matter related to "a cancer comprising a population of cells deficient in the enzyme methyladenosine phosphorylase (MTAP)" would reveal the cancer responsive to IMPDH, for example cchronic lymphocytic leukemia, chronic myelogenous leukemia, non-Hodgkins lymphoma, multiple myeloma, chronic granulocytic leukemia, cutaneous T cell lymphoma, low grade lymphomas, slow growing breast cancer, slow growing prostate cancer, and slow growing thyroid cancer.

3. Upon further consideration, the examiner vacates all the rejections of record set forth in O.A. mailed 08/10/06 and 11/01/05, and issues further restriction/election requirement in this Office Action as followings.
4. This application contains claims directed to the following patentably distinct species: (i) α -tubulin polymerization inhibitor+IMDPH combination, (ii) de novo pathway of protein biosynthesis inhibitor+IMDPH combination, (iii) a precursor of Ara-GTP+IMDPH combination,

(iv) antagonist G-protein coupled receptor(GPCR)+IMDPH combination, and (v) IMDPH monotherapy. The species are independent or distinct because they are not disclosed as capable of use together and they have different designs or modes of operation.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the instant claims of the elected Group, for example mizoribine aglycone in combination indanocine from α -tubulin polymerization inhibitor+IMDPH combination for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Furthermore, applicant is required under 35 U.S.C.121 to elect a single disclosed species from generic "cancer" group, for example prostate cancer. Moreover, whatever specific compound or disease is ultimately elected, applicants are required to list all claims readable thereon.

With the election of a specific exemplified compound and disease, a generic concept will be identified by the examiner as the inventive group for examination.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Brian Kwon
Primary Patent Examiner
AU 1614

